

**REMARKS**

## Status of the Claims

Claims 1, 2, 4-6, and 8-37 remain pending in the application, Claims 3 and 7 having been cancelled. Claims 1, 2, 18, and 23 have been amended to more clearly define the invention.

**Claims Rejected Under 35 U.S.C. § 102(e)**

The Examiner has rejected Claims 1-4, 8-18, and 22-34 as being anticipated by Leigh (U.S. Patent No. 6,728,787, hereinafter referred to as “Leigh”). The Examiner asserts that Leigh describes each element of applicants’ claimed invention. Applicants respectfully disagree, particularly in view of the amendments currently made to the claims, for the reasons discussed below.

In the interest of reducing the complexity of the issues for the Examiner to consider in this response, the following discussion focuses on independent Claims 1 and 23. The patentability of each remaining dependent claim is not necessarily separately addressed in detail. However, applicants' decision not to discuss the differences between the cited art and each dependent claim should not be considered as an admission that applicants concur with the Examiner's conclusion that these dependent claims are not patentable over the disclosure in the cited references. Similarly, applicants' decision not to discuss differences between the prior art and every claim element, or every comment made by the Examiner, should not be considered as an admission that applicants concur with the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe that all of the dependent claims patentably distinguish over the references cited. Moreover, a specific traverse of the rejection of each dependent claim is not required, since dependent claims are patentable for at least the same reasons as the independent claims from which the dependent claims ultimately depend.

Claim 1 has been amended and now generally includes a step from canceled Claim 3, that clearly distinguishes over Leigh. Regarding the rejection of Claim 3, the Examiner asserts that because Leigh teaches connecting the peripheral device to the destination computer and transferring the stored network address in the peripheral device to the destination computer (Office Action, page 4, lines 9-11), Leigh has provided a pointer to a location in the memory of the peripheral device at which the network address is stored, has communicated the pointer to the host device, has used the pointer to access the location in the memory of the peripheral device, and communicated the network address to the host device from said location. However, Leigh *fails* to teach or suggest providing a

1 pointer. The first citation provided by the Examiner in support of his argument (Leigh, column 1,  
2 lines 65-66) refers to the peripheral device containing a network address, i.e., a URL, and the second  
3 citation (Leigh, column 2, lines 1-3 and lines 50-51) refers to reading the network address and  
4 directing the computer's operating system towards a web site. Also, the third citation (Leigh,  
5 column 3, lines 19-21) still only refers to reading the network address stored in the memory device,  
6 engaging the network interface, and connecting the destination computer to the network, and the  
7 fourth citation (module 310, figure 3) again only refers to reading a network address. It appears as if  
8 Leigh is reading the network address *directly* as opposed to being providing a pointer to access the  
9 location in a memory within the peripheral device, because there is no mention of a pointer being  
10 used in Leigh. In contrast, applicants teach that the string descriptor received from the peripheral  
11 device can contain the network address, or *a pointer to an additional Uniform Resource Identifier*  
12 *Information string descriptor containing the network address*, or a network address and/or additional  
13 URI information (see applicants' specification, page 14, lines 18-21). Since there is no teaching or  
14 suggestion in Leigh of providing a pointer to an addressable location in a memory of the peripheral  
15 device, it is evident that this aspect of applicants' claimed invention is not anticipated or obvious over  
16 Leigh.

17 Claim 1 has been further amended to generally include recitation from canceled Claim 7,  
18 which also clearly distinguishes over Leigh. Regarding Claim 7, the Examiner asserts that Claim 7 is  
19 rejected under 35 U.S.C. 103(a) as being unpatentable over Leigh and in view of Fleming (U.S.  
20 Patent No. 6,473,854, hereinafter referred to as "Fleming"). However, the Examiner *does not*  
21 provide a citation to any portion of Fleming where the prior art discloses or suggests requesting  
22 permission of a user in order to communicate with a source, or once permission is received from the  
23 user, initiating the communication between the host device and the source. Applicants' review of  
24 Fleming reveals that Fleming appears to automatically communicate with the source. Fleming  
25 discloses that when the device is inserted into the computer system, the computer system reads the  
26 URL from the memory within the device and uses the URL to retrieve the current driver from the  
27 server across the network. The current driver is then automatically installed within the computer  
28 system. (See Fleming, column 4, lines 26-31.) Thus, instead of asking permission of the user,  
29 Fleming appears to automatically communicate with the source without regard for the preferences of  
30

1 the user. Accordingly, Claim 1 is further distinguished over the prior art cited and is thus patentable  
2 over that art.

3 Independent Claim 23 has also been amended to distinguish over Leigh for reasons similar to  
4 those expressed above in connection with Claim 1.

5 Accordingly, the rejection of independent Claims 1 and 23 under 35 U.S.C. § 102(e) over  
6 Leigh should be withdrawn, since Leigh neither teaches nor suggests providing a pointer to a  
7 location in the memory of the peripheral device at which the network address is stored,  
8 communicating the pointer to the host device and using the pointer to access the location in the  
9 memory of the peripheral device and communicating the network address to the host device from the  
10 location. Also, Fleming does not appear to teach or suggest enabling communication based on the  
11 user's permission.

12 Claims Rejected under 35 U.S.C. § 103(a)

13 Claims 5-7, 19-21 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over  
14 Leigh and in view of Fleming. The Examiner asserts that it would have been obvious to one of  
15 ordinary skill in the art at the time the invention was made to combine the Fleming reference with the  
16 Leigh reference to enable a device for utilization upon detection of its presence by automatically  
17 retrieving from a locator specifying the location (network address) that is stored in the memory of the  
18 device and installing the device driver once it is retrieved. However, Claims 5-7, 19-21, and 36-37  
19 depend from independent Claims 1 and 23, which are patentable for the reasons discussed above.  
20 Because dependent claims are considered to inherently include the recitation of the independent  
21 claims from which the dependent claims ultimately depend, dependent Claims 5-7, 19-21, and 36-37  
22 are patentable for at least the same reasons discussed above with regard to independent Claims 1 and  
23 23. Accordingly, the rejection of dependent Claims 5-7, 19-21 and 36-37 under 35 U.S.C. § 103(a)  
24 over Leigh in view of Fleming should be withdrawn.

25 In view of the amendments and Remarks set forth above, it will be apparent that the claims in  
26 this application define a novel and non-obvious invention, and that the application is in condition for  
27 allowance and should be passed to issue without further delay. Should any further questions remain,  
28 the Examiner is invited to telephone applicants' attorney at the number listed below.

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Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents, Alexandria, VA 22313-1450, on August 27, 2004.

Date: August 27, 2004

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